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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,637	09/22/2000	G. Victor Guyan	07752.0019	8161

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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/667,637	Applicant(s) GUYAN ET AL.	
	Examiner Vanel Frenel	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Office Action mailed on July 6, 2004.

Claims 1-33 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowse et al (2002/0072935) in view of Montagna et al (4,899,292), for substantially the same reasons given in the prior Office Action mailed on July 6, 2004. Further reasons appear hereinbelow.

(A) Claims 1-33 have not been amended and are rejected for the same reasons given in the previous Office Action.

Response to Arguments

4. Applicant's arguments filed on 11/08/04 with respect to claims 1-33 have been fully considered but they are not persuasive. Applicant's arguments will be addressed in the order they appear hereinbelow.

(A) At pages 1-4 of the response filed on 11/08/04, Applicant's argues the followings:

(1) Montagna fails to disclose or suggest enabling the selection of a payment type and fulfilling a payment of a line item based on an evaluation of the line item data.

(2) There is no motivation to combine Montagna with Rowse et al.

(3) Neither Rowse nor Montagna disclose fulfilling the payment of a line item and enabling the selection of a payment-type associated with a line item. Accordingly, the rejection is improper.

(B) With respect to Applicant first argument, Examiner respectfully submits that He has relied upon Montagna for the teaching of "enabling the selection of a payment type and fulfilling a payment of a line item based on an evaluation of the line item data". In addition, Examiner points out that Montagna clearly suggests "The user selects the desired operation. Next, system 20 displays a labor worksheet also stored in DRAM 72 which worksheet permits a user to enter the number of hours required to perform the repair, and any discount which is applicable to the repair (step 434). The data obtained from steps 426, 430, 432 and 434 is also stored in SRAM 78 for safety. Finally, either microprocessor 60 or the remote central computer 437 (FIG.4) estimates the cost of repair based on the number of labor hours, discount, and the costs of the replacement parts" which correspond to Applicant claimed feature (See Montagna, Col.14, lines 50-68). Therefore, Applicant argument is not persuasive.

(C) With respect to Applicant second argument, Examiner respectfully submits the test for obviousness is not whether the features of a secondary reference may be bodily

incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed.1326, 160 USPQ 806, *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F. 2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir.1988) citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that :

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

Examiner respectfully submits, all of the limitations which Applicant disputes as missing in the applied references, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Montagna and Rowse based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the prior Office Action. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of

Art Unit: 3626

references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(D) With respect to Applicant third argument, Examiner respectfully submits that Montagna suggests "The user selects the desired operation. Next, system 20 displays a labor worksheet also stored in DRAM 72 which worksheet permits a user to enter the number of hours required to perform the repair, and any discount which is applicable to the repair (step 434). The data obtained from steps 426, 430, 432 and 434 is also stored in SRAM 78 for safety. Finally, either microprocessor 60 or the remote central computer 437 (FIG.4) estimates the cost of repair based on the number of labor hours, discount, and the costs of the replacement parts" which correspond to Applicant claimed feature (See Montagna, Col.14, lines 50-68). Therefore, Applicant argument is not persuasive.

(E) In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Art Unit: 3626

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F
V.F

February 15, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600